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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT: Petkovsek

GROUP ART UNIT: 3639

SERIAL NO.: 09/784,479

EXAMINER: Borissov

FILING DATE: February 15, 2001

ATTY. DOCKET NO.: USA-P-01-001

INVENTION: "A SYSTEM AND A METHOD FOR AUTOMATING DELIVERY OF
COMMUNICATION BY A SPECIAL SERVICE"

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

SIR/MADAM:

This Appeal Brief is submitted in support of the Notice of Appeal filed on September 27, 2005. The Appeal was taken from the Final Rejection dated June 22, 2005.

I. REAL PARTY IN INTEREST

Glenn Petkovsek is the real party in interest in this Appeal. No assignment has been filed or recorded in the U.S. Patent Office regarding ownership interest of this application.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellant or Appellant's legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-18 are pending in this patent application. A copy

of the claims is appended hereto as the Appendix. Claims 1-18 were finally rejected by the Examiner in a Final Rejection dated June 22, 2005 and are hereby on appeal. The Final Rejection is appended hereto as Exhibit A of the Supplemental Appendix.

IV. STATUS OF AMENDMENTS

All amendments have been entered in this patent application. No amendments to the claims were made after the Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention generally relates to a system and a method for assisting in the process for generating and satisfying requirements for mailing communications. More specifically, the present invention relates to a system and a method from which customers may interact on a computer network with a database to generate a communication that complies with requirements for delivery of mail by a special service.

Independent Claim 1 defines a system to assist a user with preparation and mailing of a communication requiring delivery by a special service wherein the special service has fees associated with postage and services to effect the delivery by the special service. Claim 1 requires a computer accessible site that automatically provides the preparation of the communication requiring the delivery by the special service and automatic payment of the fees associated with the postage and the services required to effect the delivery by the special service. Further, Claim 1

requires a computer for accessing the computer accessible site via a computer network. Still further, Claim 1 requires a database accessible by the computer via the computer network wherein the database is remotely located with respect to the computer. Moreover, Claim 1 requires that the database store the communication, store instructions to assist the user to complete the communication, store criteria regarding selection of the special service appropriate for the delivery of the communication and store requirements to effect the delivery of the communication by the special service. Furthermore, Claim 1 requires that the communication in the database is selected via the computer and further wherein the communication is automatically prepared in compliance with the requirements of the delivery by the special service. In addition, Claim 1 requires that the communication is automatically mailed by the special service via the computer accessible site. (Page 10, lines 29-33; page 11, lines 24-33; page 12, lines 1-16; and page 13, lines 8-16).

Independent Claim 12 defines a method for assisting with preparation and automatic mailing of a communication requiring delivery by a special service. Further, Claim 12 requires providing a computer-accessible site. Still further, Claim 12 requires providing a database accessible by a user via the computer-accessible site wherein the database is remotely located with respect to the user wherein the database stores instructions

to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses wherein the directory of mailing addresses is accessed to confirm an address of a recipient of the communication. Moreover, Claim 12 requires inputting information into the database regarding demographics of the user via the computer-accessible site wherein the requirements to effect the delivery of the communication by the special service are based on the demographics of the user. (Page 10, lines 11-24; and page 12, lines 9-16)

Furthermore, Claim 12 requires selecting the communication in the database via the computer-accessible site. In addition, Claim 12 requires selecting a geographical region within which the communication is to be delivered. Further, Claim 12 requires preparing the communication according to selection of the geographical region. Still further, Claim 12 requires automatically mailing the communication by the special service based on the requirements to effect the delivery of the communication by the special service. Moreover, Claim 12 requires generating fees, postage costs, and special service mail provider costs and automatically paying the fees. (Page 10, lines 11-24; and page 13, lines 8-11)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-18 were rejected under 35 U.S.C. §103(a) as being obvious to one having ordinary skill in the art at the time of Appellant's invention over *Greco et al.* (U.S. Patent Application No. 2002/0120680) in view of *Heston* (U.S. Patent Application No. 2002/0019741). See *Greco et al.* attached as Exhibit B of the Supplemental Appendix and *Heston* attached as Exhibit C of the Supplemental Appendix.

VII. ARGUMENT

A. THE CITED REFERENCES AND REJECTIONS OF CLAIMS 1-18

Independent Claims 1 and 12 and dependent Claims 2-11 and 13-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Greco et al.* in view of *Heston*.

In the Final Rejection, the Examiner stated:

Greco et al. teaches a method and system for providing electronic document services, comprising:
Claims 1 and 12,
providing a service provider server and user (client) computer...
providing a database accessible by the user...
inputting user unique information into the database via the user computer... utilizing demographic and/or geographical information...
selecting a type of communication by one of the users...
automatically delivering an item by one of said document-related services...[and]
generating and transferring user fees, postage costs, and special service mail provider costs [0097].

However, *Greco* does not specifically teach that said forms include *forms, which are used for creation [of] said document (communication).*

Further, the Examiner stated that:

Heston teaches a method and system for performing legal services over the internet, wherein a client is presented with a choice of legal documents to be created. In use, the client selects the legal document that he wants to prepare, and enters into the legal document form necessary information to create the legal document.

(See Final Rejection, Pages 2 and 3 of Exhibit A of the Supplemental Appendix.)

**B. CLAIMS 1-18 WOULD NOT HAVE BEEN OBVIOUS TO
ONE OF ORDINARY SKILL IN THE ART AT THE TIME OF
APPELLANT'S INVENTION IN VIEW OF *GRECO ET AL.* AND
FURTHER IN VIEW OF *HESTON*, TAKEN SINGLY OR IN COMBINATION**

With respect to the rejection of Claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over *Greco et al.* in view of *Heston*, Appellant respectfully submits that the claims distinctly define the present invention from *Greco et al.* and *Heston*, taken singly or in combination, for the reasons that follow.

Independent Claim 1 requires a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service. Further, Claim 1 requires that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and is

automatically mailed by the special service via the computer accessible site.

Independent Claim 12 requires providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication. Further, Claim 12 requires automatically mailing the communication by the special service, generating fees and automatically paying the fees.

Contrary to the assertions of the Examiner, *Greco et al.* merely teach or suggest electronic document services that utilize a database that "may include multiple entries that contain a user identification data (ID) field 710 and user data field 720. The user ID field 710 may contain an identifier that uniquely identifies the user. The user data field 720 may include one or more subfields... a link information field 722, a service provider information field 724, and possibly a permissions field 726." Further, *Greco et al.* teach that the link information field 722 contains links to web sites maintained by service providers, the service provider information field 724 contains information about

the type of service, etc. provided by service providers, and the permissions field 726 contains information about the permissive uses of services by each user.

Contrary to the assertions of the Examiner, *Heston* merely teaches or suggests a system and method for rendering legal services that utilizes a database for storing and retrieving information that is manipulated by program logic. Further, the database stores legal forms and topical or legal area information.

Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service, as required by Claim 1. Further, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site, as required by Claim 1. *Greco et al.* merely teach providing a document to one or more service providers for performing a selected document service. *Heston* merely teaches creating a legal document over the Internet. Therefore, neither *Greco et al.* nor *Heston*, taken singly or in

combination, teaches or suggests a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service, as required by Claim 1.

Moreover, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the step of providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication, as required by Claim 12. *Greco et al.* merely teach a toolbar having activation buttons which perform different functions. *Greco et al.* fail to teach or suggest storing criteria regarding selection of the special service appropriate for the delivery of the communication or storing requirements to effect the delivery of the communication by the special service, as required by Claim 12. *Heston* fails to teach what is not taught by *Greco et al.* *Heston* merely teaches legal forms available on a database. Therefore, neither *Greco et al.* nor *Heston*, taken

singly or in combination, teaches or suggests the step of providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication, as required by Claim 12.

Furthermore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the steps of automatically mailing the communication by the special service, generating fees and automatically paying the fees, as required by independent Claim 12. Contrary to the assertions of the Examiner, *Greco et al.*, paragraph 97, merely teach: "The server 120 may also consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g., monthly bill to the user. The bill may itemize the various services to aid the user in indentifying the costs." *Heston* merely teaches transmitting information between a client and a legal entity over an electronic network. Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the steps of automatically mailing the communication by the special service, generating fees

and automatically paying the fees, as required by independent Claim 12.

Moreover, a person of ordinary skill in the art would never have been motivated to combine *Greco et al.* with *Heston* in the manner suggested by the Examiner in formulating the rejection under 35 U.S.C. §103(a). Appellant submits that the Examiner is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Appellant's calendar, method for recording information and calendar kit to deprecate the claimed invention. Of course, hindsight reconstruction of Appellant's invention is impermissible.

With the analysis of the deficiencies of *Greco et al.* and *Heston* in mind, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Greco et al.* and *Heston* in the manner suggested by the Examiner in formulating the rejection under 35 U.S.C. §103(a). Therefore, *prima facie* obviousness has not been established by the Examiner as required under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

Appellant further submits that one having ordinary skill in the art at the time of Appellant's invention would never have been

motivated to combine *Greco et al.* and *Heston* in the manner suggested by the Examiner in formulating the rejection under 35 U.S.C. §103(a).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Appellant submits that the Examiner has merely located components of Appellant's claimed invention. However, that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). Even assuming that one having ordinary skill in the art could somehow have combined *Greco et al.* and *Heston* as set forth by the Patent Office, the resultant combination still lacks the novel elements and steps positively recited in Claims 1 and 12, respectively.

Moreover, most, if not all, elements perform their ordained

and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

With respect to Claim 5, a means for generating addresses necessary for delivery based on information input by the user is required. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests a means for generating addresses necessary for the delivery of information, as required by Claim 5. *Greco et al.* merely teach "the address book management service button 450 may initiate a function to manage personal and business information of a user." *Heston* merely teaches "the web site may automatically send correspondence to the e-mail address set up by the legal entity." Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests a means for generating addresses necessary for the delivery of information, as required by Claim 5.

Claim 7 requires means for suggesting mailing requirements based on information input by the user. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests a means for suggesting mailing requirements based on information input by the user, as required by Claim 7. *Heston* merely teaches that the client may select consultation by telephone, email or in-office.

Greco et al. merely teach an overnight courier service button which may initiate overnight delivery of a document. Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests a means for suggesting mailing requirements based on information input by the user, as required by Claim 7.

Claim 8 requires a means for computing postage costs and fees to the user associated with the delivery by the special service. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or even remotely suggests a means for computing postage costs and fees to the user associated with the delivery by the special service, as required by Claim 8. Contrary to the assertions of the Examiner, *Greco et al.*, at paragraph 97, merely teach: "The server 120 may also consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g., monthly bill to the user. The bill may itemize the various services to aid the user in indentifying the costs." *Heston* merely teaches "payment for services can be configured by the legal entitiy." Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or even remotely suggests a means for computing postage costs and fees to the user associated with the delivery by the special service, as required by Claim 8.

Claim 9 requires a means for contacting a supplier necessary to complete the delivery of the communication by the special service. Neither *Greco et al.* nor *Heston*, taken singly or in

combination, teaches or even remotely suggests a means for contacting a supplier necessary to complete the delivery of the communication by the special services, as required by Claim 9. *Greco et al.* merely teach that "the user may provide the document and the delivery instructions electronically to a secure location of a service provider." *Heston* merely teach submitting information from the client to a legal entity by email. Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or even remotely suggests a means for contacting a supplier necessary to complete the delivery of the communication by the special services, as required by Claim 9.

Claim 13 requires determining required services for the delivery by the special service and costs associated with the delivery. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests determining required services for the delivery by the special service and costs associated with the delivery, as required by Claim 13. *Greco et al.* merely teach "the bill may itemize the various services to aid the user in identifying costs." *Heston* merely teaches payment for service can be configured by the legal entity. Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests determining required services for the delivery by the special service and costs associated with the delivery, as required by Claim 13.

Claim 14 requires providing suggestions for complying with requests for delivery by the special service based on the demographics input by the user and the communications chosen by the user. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests providing suggestions for complying with requests for delivery by the special service based on the demographics input by the user and the communications chosen by the user, as required by Claim 14. The Examiner merely alleges that *Greco et al.* teach providing websites of Internet-based document service providers. The Examiner fails to provide any teaching for providing suggestions for complying with requests for delivery by the special service based on demographic input by the user and the communications chosen by the user, as required by Claim 14. Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests providing suggestions for complying with requests for delivery by the special service based on the demographics input by the user and the communications chosen by the user, as required by Claim 14.

Claim 15 requires generating the communication based on information input by the user. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests generating the communication based on information input by the user, as required by Claim 15. Contrary to the assertions of the Examiner, *Heston*, at paragraph 13, merely teaches "clients will now be able to obtain

on-line legal services in real time from law firms." Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests generating the communication based on information input by the user, as required by Claim 15.

Claim 17 requires providing dates and times of steps taken by a special service mail provider in mailing the communication. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests providing dates and times of steps taken by a special service mail provider in mailing the communication, as required by Claim 17. Contrary to the assertions of the Examiner, *Greco et al.*, at paragraph 97, merely teach a "bill may itemize the various services." Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests providing dates and times of steps taken by a special service mail provider in mailing the communication, as required by Claim 17.

Claim 18 requires generating a report of actions taken by a special service mail provider. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests generating a report of actions taken by a special service mail provider, as required by Claim 18. Contrary to the assertions of the Examiner, *Greco et al.* merely teach "server 120 may consolidate the fees incurred for various document-related services requested by the user" (emphasis added). Therefore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests

generating a report of actions taken by a special service mail provider, as required by Claim 18.

Appellant further submits that absolutely no teaching, suggestion and/or incentive exists in *Heston* to combine *Heston* with *Greco et al.* in the manner suggested by the Examiner. Therefore, the rejection of Claims 1-18 under 35 U.S.C. §103(a) should be reversed.

VIII. CONCLUSION

For the foregoing reasons, Appellant respectfully submits that the rejection of Claims 1-18 is erroneous as a matter of law and fact and respectfully requests the Board to reverse the rejection.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'Brian M. Mattson', is written over the signature line.

(Reg. No. 35,018)

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A Professional Corporation
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X. TABLE OF CONTENTS

1. APPENDIX: Claims 1-18
2. SUPPLEMENTAL APPENDIX

EXHIBIT A: Final Rejection dated June 22, 2005

EXHIBIT B: *Greco et al.* (U.S. Patent Application
No. 2002/0120680)

EXHIBIT C: *Heston* (U.S. Patent Application No. 2002/0019741)

APPENDIX

1. A system to assist a user with preparation and mailing of a communication requiring delivery by a special service wherein the special service has fees associated with postage and services to effect the delivery by the special service, the system comprising:

a computer accessible site that automatically provides the preparation of the communication requiring the delivery by the special service and automatic payment of the fees associated with the postage and the services required to effect the delivery by the special service;

a computer for accessing the computer accessible site via a computer network; and

a database accessible by the computer via the computer network wherein the database is remotely located with respect to the computer wherein the database stores the communication, stores instructions to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service wherein the communication in the database is selected via the computer and further wherein the communication is automatically prepared in compliance with the requirements of the delivery by the special service and further wherein the communication is automatically mailed by the special service via

the computer accessible site.

2. The system of Claim 1 further comprising:

means for inputting the information by the user.

3. The system of Claim 1 further comprising:

a plurality of forms stored in the database.

4. The system of Claim 1 further comprising:

a directory of addresses stored in the database.

5. The system of Claim 1 further comprising:

means for generating addresses necessary for delivery based on the information input by the user.

6. The system of Claim 1 further comprising:

means for generating the communication based on the information input by the user.

7. The system of Claim 1 further comprising:

means for suggesting mailing requirements based on the information input by the user.

8. The system of Claim 1 further comprising:

means for computing postage costs and fees to the user associated with the delivery by the special service.

9. The system of Claim 1 further comprising:

means for contacting a supplier necessary to complete the delivery of the communication by the special service.

10. The system of Claim 1 further comprising:

means for storing the information input by the user and

communications generated for the user.

11. The system of Claim 1 further comprising:

means for generating a report for the user.

12. A method for assisting with preparation and automatic mailing of a communication requiring delivery by a special service, the method comprising the steps of:

providing a computer-accessible site;

providing a database accessible by a user via the computer-accessible site wherein the database is remotely located with respect to the user wherein the database stores instructions to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses wherein the directory of mailing addresses is accessed to confirm an address of a recipient of the communication;

inputting information into the database regarding demographics of the user via the computer-accessible site wherein the requirements to effect the delivery of the communication by the special service are based on the demographics of the user;

selecting the communication in the database via the computer-accessible site;

selecting a geographical region within which the communication

is to be delivered;

preparing the communication according to selection of the geographical region;

automatically mailing the communication by the special service based on the requirements to effect the delivery of the communication by the special service;

generating fees, postage costs, and special service mail provider costs; and

automatically paying the fees.

13. The method of Claim 12 further comprising the step of:

determining required services for the delivery by the special service and costs associated with the delivery.

14. The method of Claim 12 further comprising the step of:

providing suggestions for complying with requests for delivery by the special service based on the demographics input by the user and the communication chosen by the user.

15. The method of Claim 12 further comprising the step of:

generating the communication based on information input by the user.

16. The method of Claim 12 further comprising the step of:

providing the communication to the user via a display screen.

17. The method of Claim 12 further comprising the step of:

providing dates and times of steps taken by a special service mail provider in mailing the communication.

18. The method of Claim 12 further comprising the step of:
generating a report of actions taken by a special service mail
provider.



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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT: Petkovsek

GROUP ART UNIT: 3639

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EXAMINER: Borissov

FILING DATE: ~~February~~ 15, 2001

ATTY. DOCKET NO.: USA-P-01-001

INVENTION: "A SYSTEM AND A METHOD FOR AUTOMATING DELIVERY OF
COMMUNICATION BY SPECIAL SERVICE"

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S APPEAL BRIEF TRANSMITTAL LETTER

SIR/MADAM:

Appellant submits herewith Appellant's Appeal Brief in support of the Notice of Appeal filed September 27, 2005. Appellant encloses a check for \$250.00 for submission of this Appeal Brief. Appellant authorizes the Patent Office to charge any fees that may be due and owing or to credit any overpayment to Deposit Account No. 50-0595. A duplicate copy of this sheet is enclosed for this purpose.

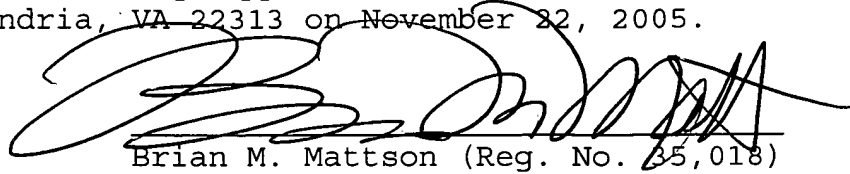
Respectfully submitted,

(Reg. No. 35,018)

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CERTIFICATE OF MAILING

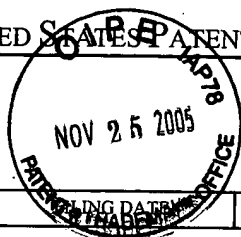
I hereby certify that this **APPEAL BRIEF with APPENDIX CONTAINING CLAIMS 1-18, SUPPLEMENTAL APPENDIX CONTAINING EXHIBITS A, B, and C and check for \$250.00** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, Alexandria, VA 22313 on November 22, 2005.

A handwritten signature in black ink, appearing to read 'Brian M. Mattson', is written over a horizontal line.

Brian M. Mattson (Reg. No. 35,018)



UNITED STATES PATENT AND TRADEMARK OFFICE



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,479	02/15/2001	Glenn Petkovsek	USA-P-00-001	1689

7590

06/22/2005

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EXAMINER

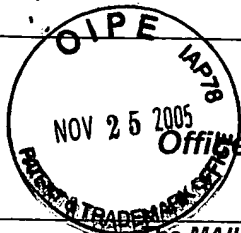
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/784,479

Applicant(s)

PETKOVSEK, GLENN

Examiner

Igor Borissov

Art Unit

3639

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Amendment received on 4/01/2005 is acknowledged and entered. Claims 1-3 and 12 have been amended. Claims 1-18 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. (US 2002/0120680 A1) in view of Heston (US 2002/0019741 A1).

Greco et al. (Greco) teaches a method and system for providing electronic document services, comprising:

Claims 1 and 12,

providing a service provider server and user (client) computer; said server and user computer are configured to communicate over the Internet; said user computer includes a browser to locate said service provider on the Internet [0006]; [0051]; [0089];

providing a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information relating to processing and delivery of a document (communication) by Internet-based document-related services (special service) [0012]-[0014]; [0051]; said information further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084];

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inputting user unique information into the database via the user computer; wherein services recommended are selected based on a location (e.g., city, state, country) [0082]; [0084]; thereby indicating utilizing demographic and /or geographical information;

selecting a type of communication by one of the users [0062]; [0084];

automatically delivering an item by one of said document-related service [0062] – [0069];

generating and transferring user fees, postage costs, and special service mail provider costs [0097].

Furthermore, Greco teaches that said server obtains necessary information from the user via convenient forms provided to the user [0089].

However, Greco does not specifically teach that said forms include *forms, which are used for creation said document* (communication).

Heston teaches a method and system for performing legal services over the Internet, wherein a client is presented with a choice of legal documents to be created. In use, the client selects the legal document that he wants to prepare, and enters into the legal document form necessary information to create the legal document [0105]; [0025]; [0006].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Greco to include that said database, residing in said service provider server remotely from the user computer, includes forms which are used for creation of a document, as disclosed in Heston, because it would advantageously simplify a whole process of creation of a document and delivering it to a recipient. Information as to *special* service is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior

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art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

Claim 2, Greco teaches means for inputting information (260) by each of the users [0053].

Claim 3, Heston teaches a plurality of forms stored in the database, said forms are to be used in creation of a document [0027]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

Information as to *wherein the users may choose any one of the plurality of forms* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 3 are disclosed in Greco in view of Adams as described herein. Also as described the limitations of the claim 3 do not distinguish the claimed apparatus from the prior art.

Furthermore, Greco teaches:

Claim 4, a directory of addresses stored in the database [0013]; [0062].

Claim 5, means for generating addresses necessary for delivery based on information input by the user [0062]; [0071].

Claim 6, means for generating communications based on the information input by the user [0012].

Claim 7, means for suggesting mailing requirements based on information input by the user [0012].

Claim 8, means for computing postage costs and fees to the user associated with delivery by the special service [0097].

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Claim 9, means for contacting a supplier necessary to complete delivery of the communication by the special service [0046].

Claim 10, means storing information by each of the users [0082]; [0084].

Claim 11, means for generating a report for the user [0097].

Claim 13, determining required services for delivery by the special service and costs associated with the delivery [0012]; [0097].

Claim 14, providing links to web-sites of said Internet-based document-related service providers [0084] based on information input by the user [0012] and location information (e.g., city, state, country) [0082]; [0084]; thereby obviously indicating utilizing demographic information.

Claim 15, Heston teaches: generating the communication based on the information input by the user [0013]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

Claim 16, Heston teaches: providing the communication to the user via a display screen [0010]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

Claim 17, Greco teaches: itemizing services taken by said Internet-based document-related service providers [0097].

Claim 18, Greco teaches: generating a report for the user [0097].

Response to Arguments

Applicant's arguments filed 4/01/2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art does not teach a database that stores the communication, stores instructions to assist the user to completely prepare selection of the communication and stores requirements to effect the delivery the communication, it is noted that Greco teach this feature. Specifically,

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Greco teaches a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information relating to processing and delivery of a document (communication) by Internet-based document-related services (special service) [0012]-[0014]; [0051]; said information further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084].

In response to the applicant's argument that the prior art does not teach that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site, it is noted that Heston teaches that a client accesses a Web site to select a document that he wants to prepare, and enters information necessary to create the document [0105]; [0025]; [0006]. As per mailing step, Greco teaches this feature [0040].

In response to the applicant's argument that the prior art fails to teach the step of inputting information into said database regarding demographics or the user, and selecting a geographical region within which the communication is to be delivered and preparing the communication according to selection of the geographical region, it is noted that Greco teaches inputting user unique information into the database via the user computer; wherein services recommended are selected based on a location (e.g., city, state, country) [0082]; [0084]; thereby indicating utilizing demographic and /or geographical information; selecting a type of communication by one of the users [0062]; [0084]; and automatically delivering an item by one of said document-related service [0069].

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing document related services over the Internet. The motivation to combine modify Greco to include that said remote database, residing in said service provider server, includes forms which are used for creation of a document, as disclosed in Heston, would be to simplify a whole process of creation of a document and delivering it to a recipient.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Hayes, can be reached at (571) 272-6708.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

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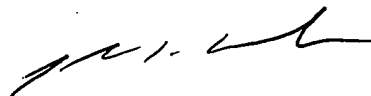
or faxed to:

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[Official communications; including After Final
communications labeled "Box AF"]

IB

6/17/2005



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